

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Notice of references cited (PTO Form 892)

Applicant wishes to note that the U.S. patent 5,169,155 (Soules) applied in the 35 U.S.C. 103 rejection is not listed on the form 892. It appears as though the cited U.S. patent 6,169,155 (Alvarez) was inadvertently included instead of the Soules patent.

Applicant respectfully requests that U.S. patent 5,169,155 (Soules) be added to the PTO form 892.

2. In the specification

The specification is amended to add customary specification section headings.

The specification is further amended to replace "WO 98/39428" with "WO 97/39428" in the background of the invention. It is abundantly clear that the citation of the WO 98/39428 publication was due to a typographical error as this publication relates to a method for inducing mutations in the production of a vaccine, whereas the WO 97/39428 publication is directed to a document of value.

Entry of the Amendment to the specification is respectfully requested in the next Office action.

2. In the claims

Claims 10, 11, 14, 15, 17, 20, 22, 23 and 25-28 are amended to improve the clarity of the claim language and to provide proper antecedent basis to all features recited in the claims.

These amendments are not meant to have a narrowing effect for the purpose of patentability.

No new matter is added.

Entry of the Amendment to the claims is respectfully requested in the next Office action.

2. Rejection of claims 1, 6-11, 14, 16-19, 22-25 and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0050891 (*Cohen*) in view of U.S. patent 5,169,155 (*Soules*)

Reconsideration of this rejection is respectfully requested in view of the following remarks with respect to independent claim 1 which demonstrate that the proposed combination of *Cohen* and *Soules* fails to render the pending claims *prima facie* obvious. Claims 6-11, 14, 16-19, 22-25 and 30 are at least patentable in view of their dependency from independent claim 1.

In observing claim 1, the claim is drawn to a value document having at least two different feature substances for checking the document, wherein first and second feature substances form mutually independent codings.

As described in the specification in paragraphs [0009] and [0010], this arrangement allows a first group of users to use the first feature substance for authenticity checking and value recognition and a second group of users to use the second feature substance for authenticity checking and value recognition. With this arrangement, knowledge of the procedure of one group does not reveal the substances and methods used for authenticity checking and value recognition by another group.

None of the cited references contemplate providing at least two different feature substances on the same value document for checking the value document, wherein first and second feature substances form mutually independent codings. As such, the proposed combination of *Cohen* and *Soules* fails to render independent claim 1 *prima facie* obvious.

Particularly, the proposed combination of *Cohen* and *Soules* lacks the requisite suggestion or motivation to properly combine the references.

*Cohen* discloses a system for the registration and tracking of items through a database. In observing Fig. 1, a tracking check 136 has a bar code field 136-7 which includes a tracking number 134. The rejection relies on the bar code 136-7 as a teaching of the first feature substance in the pending claims. As the bar code reveals all of the information desired in *Cohen*, *Cohen* does not in the least contemplate applying a second different feature substance on the tracking check.

*Soules* discloses a coded playing card having a machine readable inklessly marked bar code 11 which identifies the face value and suit of the card (col. 9, lines 5-8, 19-21, and 43-45). The rejection relies on the bar code 11 as a teaching of the second feature substance of the pending claims. In observing Fig. 1, *Soules* also does not contemplate applying a second different feature substance to the card in addition to the bar code 11.

In clear distinction to both *Cohen* and *Soules*, the value document of the pending claims has at least two different feature substances which form mutually independent codings.

As both *Cohen* and *Soules* only disclose a single bar code respectively on the tracking check in *Cohen* and the playing card in *Soules* and do not contemplate the provision of more than one bar code, neither of these documents provide a suggestion or motivation to include a second different feature substance, as is required by claim 1.

Indeed, one of ordinary skill in the art would not understand from the teachings in *Cohen* and *Soules* or from the general knowledge of the art to apply the bar code on the playing card in *Soules* to the tracking check in *Cohen* in addition to the bar code already present on the tracking check.

As there is no suggestion or motivation in either *Cohen* or *Soules* or within the general knowledge of the art to apply the bar code on the playing card in *Soules* to the tracking check in *Cohen*, the proposed modification suggested in the rejection lacks the requisite motivation or suggestion necessary to properly modify the reference.

As such, the proposed combination of *Cohen* and *Soules* fails to render the pending claims *prima facie* obvious. Accordingly, withdrawal of this rejection is respectfully requested.

Additionally, Applicant wishes to note that *Cohen* does not even disclose the application of a feature substance. Indeed, the bar code 136-7 is not a feature substance in accordance with the feature substances described in the present application with respect to various luminescent properties.

Furthermore, claim 1 recites that the feature substances are for checking the value document. *Cohen* does not disclose that the bar code is used in any way to check the authenticity of the tracking check.

Accordingly, withdrawal of this rejection is respectfully requested.

3. Rejection of claims 2-5, 13, 15, 21, 26-29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0050891 (*Cohen*) in view of U.S. patent 5,169,155 (*Soules*) and further in view of U.S. patent 6,506,476 (*Kaule*)

Rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0050891 (*Cohen*) in view of U.S. patent 5,169,155 (*Soules*) and further in view of U.S. patent application publication 2004/0084277 (*Blair*)

Rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0050891 (*Cohen*) in view of U.S. patent 5,169,155 (*Soules*), U.S. patent application publication 2004/0084277 (*Blair*), and further in view of U.S. patent 6,506,476 (*Kaule*)

Reconsideration of this rejection is respectfully requested in light of the observations noted above with respect to independent claim 1, from which claims 2-5, 12, 13, 15, 20, 21, 26-29, 31 and 32 depend.

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It is submitted that *Kaule* and *Blair* do not make up for the shortcomings of *Cohen* and *Soules* and thus claims 2-5, 12, 13, 15, 20, 21, 26-29, 31 and 32 are patentable at least in view of their dependency from claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

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5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Justin J. Cassell', written in a cursive style.

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